

II. Rejection under Nonstatutory Double Patenting

The Examiner rejects claims 18-21, 24-34, 36-39, 51 and 52 under the judicially created doctrine of obviousness-type double patenting as "being unpatentable over claims 1-21 and 24 of U.S. Patent No. 6,338,858," filed on March 16, 1998. Office Action dated September 12, 2003, at 2. The Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other." Id.

Applicant respectfully disagrees with the Examiner. However, in the interest of advancing prosecution, Applicant is filing, concurrently with this Response, a terminal disclaimer in this application with respect to U.S. Patent No. 6,338,858. Accordingly, Applicant respectfully requests that the Examiner withdraw the non-statutory double patenting rejection.

III. Rejection under 35 U.S.C. § 103(a) over O'Neill et al.

The Examiner rejects claims 18-21, 24-34, 36, 39, and 51-53 under § 103(a) over U.S. Patent No. 4,300,580 to O'Neill et al. ("O'Neill"). See Id. at 4. In reply to the arguments presented by Applicant in the Response after Final filed May 27, 2003, the Examiner asserts the following arguments: First, the Examiner states that consideration of a reference "extends to the entire disclosure for what it fairly teaches when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art." Id. at 7 (citations omitted). Second, the Examiner asserts that "example 1 of O'Neill specifically teaches a compound of formula (I), as instantly claimed." Id. at 8. Third, citing case law, the Examiner argues that "a compound and its properties are inseparable"; and that

“since O'Neill teaches the same compounds of formula (I), as those of the instant invention, the rheological properties must be the same.” Id. at 5 (citations omitted) and 8.

Applicant respectfully disagrees with the Examiner, both in the Examiner's factual assertions and in the Examiner's application of the case law, for at least the reasons of record and those set forth below. Applicant maintains that the Examiner has not established a prima facie case of obviousness, at least because the Examiner has not established that all of the elements of the instant rejected claims are taught or suggested by O'Neill.

The Examiner asserts that “the instant invention and O'Neill teach the same compounds for formula (I), with the same ‘n’ values.” Id. at 8. Applicants respectfully submit that the Examiner's assertion is simply wrong as it ignores a limitation of instant claim 18. Claim 18 requires in relevant part that “at least 35 mol% of said units of formula (I) are units of formula (I) wherein A is a 1,4-phenylene group and n is equal to 1.” Instant claim 18 (emphasis added). O'Neill, on the other hand, specifically teaches throughout its entirety that “n is an integer of from two to about ten,” in the formula relied upon by the Examiner. See, e.g., O'Neill at col. 2, line 51 (emphasis added). Moreover, the Examiner has not shown and cannot show that O'Neill suggests that “n” can be equal to one, particularly since O'Neill teaches in the opposite direction. Specifically, O'Neill starts the low end of the range of “n” at 2, and extends the upper range of “n” to more than double the upper limit of the “n” of the present invention. Thus, O'Neill is directed to increasing the value of “n” greater than 2, rather than decreasing this value. Therefore, O'Neill cannot teach a compound of formula (I) as

instantly claimed, and the Examiner has failed to make a prima facie showing of obviousness since O'Neill does not teach or suggest all the claim elements.

Further, the Examiner has failed to make a prima facie case of obviousness regarding the rheological and molecular weight properties recited in instant claim 18. In addition to the facts discussed above, there is no direct teaching or even a suggestion in O'Neill that indicates the viscosities, with the shear strains, of the instant claims. Furthermore, O'Neill is completely silent with regard to disclosing a molecular weight for any of the possible combinations, including the examples, much less the "weight-average molecular mass" recited in the present claims, i.e., "less than 20,000 polystyrene equivalents." Instant claim 18.

In addition, Applicant respectfully disagrees with the Examiner's application of case law. In particular, the decision In re Papesch, cited by the Examiner for the proposition that "a compound and its properties are inseparable," actually held that a compound can be patented on the basis of its properties, i.e., "[t]here is no basis in law for ignoring any property." 315 F.2d 381, 137 U.S.P.Q. 43 (C.C.P.A. 1963). The Examiner also cites In re Aller, which held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation." 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955). However, the court in In re Antonie reversed a PTO rejection that reviewed the application as though it were applying a standard that "it would always be obvious for one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that

the prior art recognized that particular parameter affected the result.” 559 F.2d 618, 620 (C.C.P.A. 1977) (emphasis in original).

In the present case, not only does O'Neill not teach the same compounds of formula (I) as claimed, O'Neill does not teach or suggest the rheological or molecular weight properties that are optimized in the present invention.

Thus, for at least the reasons discussed above, the Examiner failed to establish a prima facie case of obviousness, and Applicant respectfully requests that the Examiner withdraw her rejection.

IV. Rejection under 35 U.S.C. § 103(a) over O'Neill in view of Lee et al.

The Examiner also rejects claims 37-50 under § 103(a) over U.S. Patent No. 4,300,580 to O'Neill as applied to claims 18-21, 24-34, 36, 39, and 51-53, in view of EP 0551748 to Lee et al. (“Lee”). See Office Action at 6. The Examiner contends that O'Neill is deficient only in that it lacks a fatty phase and a device. Id. Thus, the Examiner presents Lee, which she asserts is directed towards hair care, teaches C10-C20 fatty alcohol esters and a spray device. Id. Again, Applicant respectfully disagrees with the Examiner.

As Applicant discussed above, the Examiner failed to make a prima facie showing of obviousness with respect to O'Neill. Lee cannot not remedy O'Neill's deficiencies with regard to instant claim 18, and thus, Lee and O'Neill combined cannot make a prima facie showing of obviousness: the references combined do not teach or suggest the presently claimed invention, nor do they motivate one of ordinary skill in the art to make the claimed invention.

In addition, the Examiner apparently ignored the elements of the instant claims, and has not shown any substantial evidence that would warrant combining the references. See In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (holding that unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, a rejection over a combination of references is improper and should be withdrawn).

Thus, for at least the reasons stated above, the Examiner has not established a prima facie showing of obviousness, and Applicant respectfully requests that the Examiner withdraw the rejection.

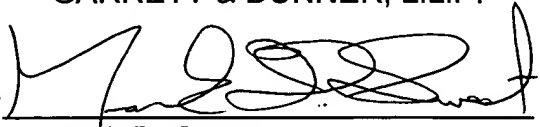
CONCLUSION

In view of the foregoing remarks, Applicant submits that the pending claims are not obvious in view of the prior art reference cited against this application. Applicant therefore requests the Office's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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